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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	79141996
Applicant	GIORGIO S.R.L.
Applied for Mark	F**K PROJECT
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Submission	Reply Brief
Attachments	1722-336 Reply Brief.pdf(420115 bytes)
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Date	06/10/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

APPLICANTS: GIORGIO S.R.L., MAURO RUSSO, PAOLO GUIDI, ALESSANDRO
ANTONIO AMBROGIO FALCONIERI, and M&M CONSULTING LICENSING S.R.L.

SERIAL NO.: 79/141,996

CLASSES: 18 and 25

FILED: October 18, 2013

EXAMINER: Christine Martin

MARK: F**K PROJECT (Stylized)

LAW OFFICE: 104

REPLY BRIEF OF APPLICANT

Applicant has appealed the Trademark Examining Attorney's refusal to register the mark "F**K PROJECT (Stylized)" on the Principal Register under Trademark Act § 2(a) claiming that Applicant's mark consists of or includes immoral or scandalous matter. Applicant hereby files this Reply Brief to the Examining Attorney's Appeal Brief in accordance with Trademark Rule 2.142(b)(1).

The Applicant firmly believes that it is impossible for the fanciful term "f**k" to be considered immoral and scandalous, because there is no such word. The term "f**k" is not present in the dictionary, and there is no commonly accepted definition of the term "f**k". Instead, the term "f**k" is a made up word that is incapable of offending or shocking the public decency, because each consumer who encounters the term will likely interpret the coined word differently. Thus, Applicant respectfully disagrees and believes that the Examiner has failed to make a *prima facie* showing of the immoral and scandalous nature of Applicant's mark. Moreover, even if the Examining Attorney was correct that the fanciful term "f**k" is a commonly understood substitute for the word "fuck," and that the word "fuck" is immoral or scandalous, such evidence would be insufficient to find that the term "f**k" itself is immoral or scandalous. A substitute for a vulgar word is not itself vulgar.

I. IF THE BOARD DETERMINES THAT APPLICANT'S MARK IS BARRED UNDER SECTION 2(a) OF THE LANHAM ACT, THIS APPEAL SHOULD BE SUSPENDED BASED UPON THE FEDERAL CIRCUIT'S DISPOSITION OF A CASE THAT WOULD BE BINDING UPON THE TTAB

On April 27, 2015, the Court of Federal Appeals for the Federal Circuit issued an Order vacating its April 20, 2015 opinion in *In re Tam*, Appeal No. 2014-1203, in which the Federal Circuit affirmed the TTAB's ruling that the mark "THE SLANTS" was in violation of Section 2(a) of the Lanham Act. *See* [Exhibit A, Federal Circuit Order]. The CAFC *sua sponte* ordered that the appeal be reinstated and be considered by the court *en banc*. *In re Tam*, 114 USPQ2d 1469 (Fed. Cir. 2015). *See id.* The issue on appeal in that case is the constitutionality of Section 2(a) of the Trademark Act. *See id.* The court's Order requests that the parties file new briefs addressing the following question:

Does the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?

See id. Because the Federal Circuit's decision about the constitutionality of Section 2(a) of the Lanham Act would be binding upon the TTAB, and may invalidate Section 2(a) of the Trademark Act, which serves as the basis upon which Applicant's mark has been rejected, Applicant respectfully requests that this Appeal be suspended pending the Federal Circuit's decision.

II. CONCLUSION

Based on the arguments and analysis contained within Applicant's Trial Brief, Applicant requests that the Trademark Trial and Appeal Board reconsider the original rejection of this application. As such, Applicant believes the mark "f**k" is fanciful and should not be considered immoral and scandalous and respectfully requests that the present mark be passed to publication at an early date.

If the Trademark Trial and Appeal Board believes that Applicant's mark would be considered scandalous and is therefore barred under Section 2(a) of the Lanham Act, Applicant respectfully requests that this Appeal be suspended pending disposition of the Federal Circuit's appeal of *In re Simon Shiao Tam*, Case No 2014-1203. Suspension would be proper, because the Federal Circuit's decision implicates the constitutionality of Section 2(a) of the Lanham Act that Applicant's mark was rejected upon, and the Federal Circuit's decision would have a binding effect on the TTAB.

Respectfully submitted,

June 10, 2015
Date

/1722-336/
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Our File: 1722-336

Exhibit "A"

United States Court of Appeals for the Federal Circuit

IN RE: SIMON SHIAO TAM,
Appellant

2014-1203

Appeal from the United States Patent and Trademark
Office, Patent Trial and Appeal Board in No. 85472044.

SUA SPONTE HEARING EN BANC

Before PROST, *Chief Judge*, NEWMAN, LOURIE, DYK,
MOORE, O'MALLEY, REYNA, WALLACH, TARANTO, CHEN, and
HUGHES, *Circuit Judges*.

PER CURIAM.

ORDER

This case was argued before a panel of three judges on January 9, 2015. A sua sponte request for a poll on whether to consider this case en banc in the first instance was made. A poll was conducted and the judges who are in regular active service voted for sua sponte en banc consideration.

Accordingly,

IT IS ORDERED THAT:

(1) The panel opinion of April 20, 2015 is vacated,
and the appeal is reinstated.

(2) This case be heard en banc sua sponte under 28 U.S.C. § 46 and Federal Rule of Appellate Procedure 35(a). The court en banc shall consist of all circuit judges in regular active service who are not recused or disqualified.

(3) The parties are requested to file new briefs. The briefs should address the following issue:

Does the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?

(4) This appeal will be heard en banc on the basis of the additional briefing ordered herein, and oral argument. An original and thirty copies of the new en banc briefs shall be filed, and two copies of each en banc brief shall be served on opposing counsel. Appellant's en banc brief is due 45 days from the date of this order. Appellee's en banc response brief is due within 30 days of service of appellant's en banc brief, and the reply brief within 15 days of service of the response brief. Briefs shall adhere to the type-volume limitations set forth in Federal Rule of Appellate Procedure 32 and Federal Circuit Rule 32.

(5) Briefing should be strictly limited to the issue set forth above.

(6) Briefs of amici curiae will be entertained, and any such amicus briefs may be filed without consent and leave of court but otherwise must comply with Federal Rule of Appellate Procedure 29 and Federal Circuit Rule 29.

(7) Oral argument will be held at a time and date to be announced later

FOR THE COURT

April 27, 2015
Date

/s/ Daniel E. O'Toole
Daniel E. O'Toole
Clerk of Court